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**Remarks:**

Applicants believe this response to be fully responsive to the Office Action mailed May 19, 2004. Claims 1-25 and 32-37 are still pending in the application.

**Claim Rejections under 35 U.S.C. §112**

Claims 1-25 and 33-37 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Applicants respectfully submit that claim 1 includes "a diverter mechanism positioned at each of said spurs, said diverter mechanism being operable to selectively divert containers from said conveying surface onto the associated one of said spurs". Claim 1 does not refer to any other diverter, particularly one that diverts items from the spur onto a cart loading mechanism. Moreover, Applicants submit that there is no other "diverter" in any of the claims that diverts items from the spur onto a cart loading mechanism, nor is there any reference to a "cart loading mechanism" in the claims. To the contrary, the claims clearly include "at least one transport mechanism which transports containers from each of said spurs to a dispatch cart juxtaposed with that spur". Applicants respectfully submit that the claims are not indefinite. Reconsideration and withdrawal of the rejection under 35 U.S.C. §112 is respectfully requested.

**Claim Rejections under 35 U.S.C. §103**

Claims 1-25 and 33-37 were rejected under 35 U.S.C. §103(a) as being unpatentable over Bernard II, et al. U.S. Patent No. 5,472,309, in view of Sjogren et al., U.S. Patent No. 5,181,820. Claim 32 was rejected under 35 U.S.C. §103(a) as being unpatentable over Bernard in view of Sjogren, and in further view of Huang et al., U.S. Patent No. 5,505,291.

Applicants respectfully traverse the rejections under 35 U.S.C. §103(a) for the reasons set forth below.

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As set forth in claim 1, the claimed invention is a mail container postal dispatch system which dispatches randomly arranged containers of sorted mail to particular dispatch carts. The postal dispatch system comprises a sortation conveyor having a main conveying line defined by a conveying surface that conveys randomly arranged containers of sorted mail; a plurality of spurs extending from the main line in the direction of particular dispatch carts; a diverter mechanism positioned at each of the spurs; and at least one transport mechanism. The diverter mechanism is operable to selectively divert containers from the conveying surface onto the associated one of the spurs, while the at least one transport mechanism transports containers from each of the spurs to a dispatch cart juxtaposed with that spur.

Applicants respectfully submit that Bernard, either alone or in combination with Sjogren or any other cited reference, does not disclose, teach, suggest or render obvious the mail container postal dispatch system of the present invention, particularly as set forth in independent claim 1 and the claims depending therefrom. To the contrary, Bernard discloses a system for storing and retrieving goods and preparing the goods for their ultimate disposition. The delivery system conveys boxes from a continuous loop to a particular workstation or storage carousel. The boxes are conveyed to a storage carousel for storage or are conveyed to a workstation where an operator manually works on the article, such as at a pack/wrap workstation. The system of Bernard thus is not a postal dispatch system, and there is no disclosure or suggestion in Bernard of a plurality of spurs extending from the main line in the direction of particular dispatch carts. Moreover, there is no disclosure or suggestion in Bernard of any dispatch carts or of a transport mechanism which transports containers from each of the spurs to a dispatch cart juxtaposed with that spur.

Likewise, Applicants submit that Sjogren, either alone or in combination with Bernard or any other cited reference, does not disclose, teach, suggest or render obvious the mail container postal dispatch system of the present invention, particularly as set forth in independent claim 1 and the claims depending therefrom. To the contrary, Sjogren discloses an automatic bundle loading apparatus for loading newspaper bundles into carts. The bundles are moved along a conveyor to a platform and loaded into carts at the platform. The Sjogren apparatus merely collects bundles of newspapers and loads them into carts. Sjogren thus does

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not disclose a sortation conveyor for conveying randomly arranged containers of sorted mail and, thus, does not disclose the postal dispatch system of the claimed invention. Moreover, there is no disclosure or suggestion in Sjogren of a plurality of spurs extending from the main line in the direction of particular dispatch carts. There is also no disclosure or suggestion in Sjogren of a diverter mechanism positioned at spurs and operable to selectively divert containers from the conveying surface onto the associated one of the spurs.

Furthermore, Applicants submit that there is no motivation to combine the teachings of Sjogren with the teachings of Bernard. Bernard teaches a warehousing system for sorting and retrieving goods and preparing goods for their ultimate disposition, while Sjogren teaches a newspaper bundle loading apparatus that loads bundles of newspapers into carts. The systems are thus substantially different and intended for substantially different tasks.

Applicants submit that there must be some suggestion or motivation to modify the reference or to combine the teachings of the references, and the combination of the reference must teach or suggest all of the claim limitations. As is well settled, the teaching or suggestion to make the claimed combination must be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990). If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims obvious. *In re Ratti*, 123 USPQ 349 (CCPA 1959).

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In the present case, Bernard teaches a system that conveys goods to workstations and/or storage carousels, while Sjogren teaches an apparatus that conveys bundles of newspapers to a platform for loading into carts positioned at the platform. There is no suggestion or motivation to combine the teachings, and the combination of Sjogren with Bernard would change the principle of operation of the system of Bernard, such as by adding carts to the storage system. Applicants thus submit that citing Sjogren to show an apparatus to load carts, and combining that with Bernard, which shows a delivery system that conveys articles to workstations or storage carousels, and then claiming that this combination renders obvious the mail container postal dispatch system of the present invention (which dispatches randomly arranged containers of sorted mail to particular dispatch carts), does not take into account the purpose and operation of either of the cited teachings and is thus improper.

In the Office Action, the Examiner states that the suggestion/motivation would have been to provide a means to load carts with items for delivery at various spurs. Applicants respectfully disagree. There is no disclosure or suggestion of providing carts of any type to the Bernard storage system. Bernard discloses a storage system and workstation system where goods are conveyed to appropriate workstations and/or to appropriate storage carousels. There is no disclosure or suggestion of any carts in the Bernard system because the object of the Bernard system is to automatically deliver the goods to the appropriate workstation and/or to the appropriate storage carousel, presumably to obviate any need for carts or manual movement/delivery of the goods. Bernard thus teaches away from providing carts and loading carts. Therefore, the combination of the cart loading apparatus of Sjogren with the delivery system of Bernard would substantially change the principle of operation of the Bernard system and, thus, is improper.

Moreover, even if the references are combined, the combined teachings do not result in the claimed invention. Neither of the cited references, nor the combination thereof, discloses or suggests a mail container postal dispatch system that dispatches randomly arranged containers of sorted mail to particular dispatch carts, and that selectively diverts containers from a conveying surface onto a spur and to a particular dispatch cart juxtaposed with that spur. Therefore, Applicants submit that, even if one were to combine the

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disclosures of the Bernard and Sjogren patents, the combination fails to teach or suggest all of the limitations of independent claim 1 and the claims depending therefrom.

With respect to the rejection of claim 32 as being unpatentable over Bernard in view of Sjogren and further in view of Huang et al., Applicants respectfully submit that this combination does not disclose, teach, suggest or render obvious the postal dispatch system of the present invention as set forth in claim 32 for at least all of the reasons set forth above.

Accordingly, Applicants respectfully submit that Bernard and/or Sjogren, either alone or in combination with one another or any other cited reference, do not disclose, teach, suggest or render obvious the mail container postal dispatch system of the present invention, particularly as set forth in independent claim 1 and the claims depending therefrom. Reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) is respectfully requested.

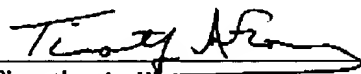
Claims 1-25 and 32-37 are pending in the application. Applicants respectfully submit that claims 1-25 and 32-37 are in condition for allowance and a notice to that effect is earnestly and respectfully requested.

Respectfully submitted,

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